

## **REMARKS/ARGUMENTS**

Prior to the present amendment, Claims 22-34 were pending in this application and were rejected on various grounds. Claims 22-27 have been amended and claims 30 and 31 have been canceled. All amendments are fully supported by the specification as originally filed, and do not add new matter. Specific support for the phrase "\_wherein said polypeptide is encoded by nucleic acid amplified in lung or colon tumor" is in Example 16 and in priority application Serial No. 60/162,506 filed on October 29, 1999.

### **The Office Action Is Not Based on Current Claims**

From the priority determination, the prior art rejection, and the explanation of the claim rejections under 35 U.S.C. 112 it is clear that the present Office Action does not take into account the Supplementary Preliminary Amendment filed on June 20, 2002 (correcting the claims), and a further Supplementary Preliminary Amendment filed on July 7, 2003 (directing similar corrections in the specification). For the Examiner's convenience, copies of both Preliminary Amendments are enclosed.

The present application claims PRO3434 polypeptides. The claims originally correctly identified Figure 16 as showing the amino acid sequence of these polypeptides but erroneously referred to SEQ ID NO: 24 as the corresponding SEQ ID NO. The Supplementary Preliminary Amendment dated June 20, 2002 corrected this error by amending the claims to refer to Figure 16, SEQ ID NO: 22. Similar corrections in the specification were made by the Supplementary Preliminary Amendment dated July 7, 2003. Accordingly, the claims pending in this application relate to the polypeptide shown in SEQ ID NO: 22, and its variants.

### **Priority**

According to the Office Action, priority is granted to provisional application No. 60/113,145 filed on December 16, 1998. In fact, the sequence of PRO3433 (SEQ ID NO: 22) was first disclosed in provisional application No. 60/119,537 filed on February 10, 1999. Accordingly, the present application should be accorded the priority date of February 10, 1999. The correct priority chain is apparent from the Preliminary Amendment filed on August 30, 2002,

which correctly claims the priority of provisional application No. 60/119,537 and does not claim the priority of provisional application No. 60/113,145 filed on December 16, 1998.

**Claim Rejections - 35 U.S.C. § 112**

Claims 22-27, 29, 30, 31, 33 and 34 were rejected under 35 U.S.C. 112, first paragraph allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, has possession of the claimed invention.

Claims 30 and 31 have been canceled. The rejection of the remaining claims is respectfully traversed.

Without acquiescing to the propriety of this rejection, Applicants have amended the claims to include the following functional recitation: "wherein said polypeptide is encoded by nucleic acid amplified in lung or colon tumor." Example 14 of the Written Description Guidelines clearly shows that the written description requirement is met by a genus in which all species within the genus are unified by a common function. In a case where (1) the procedures for making such variant proteins are routine in the art, (2) the specification provides an assay for detecting the functional activity of the protein and (3) the variant proteins possess the specified functional activity a given limited degree of sequence identity to the sequence actually disclosed and tested, the written description requirement is met.

Applicants note the Examiner's comments on the recitations "signal peptide" and "extracellular domain." Example 11, describing the isolated of cDNA encoding human PRO3434 states: "Clone DNA77631-2537 contains a single open reading frame with an apparent translational initiation site at nucleotide positions 46-48 and ending at the stop codon at nucleotide positions 3133-3135 (Figure 15). The predicted polypeptide precursor is 1029 amino acids long (Figure 16). The full-length PRO3434 protein shown in Figure 16 has an estimated molecular weight of about 114,213 daltons and a pI of about 6.42. Analysis of the full-length PRO3434 sequence shown in Figure 16 (SEQ ID NO:22) evidences the presence of very important polypeptide domains as shown in Figure 16. Clone DNA77631-2537 has been

deposited with ATCC on February 9, 1999 and is assigned ATCC deposit no. 203651." Figure 16, in turn, clearly identifies amino acids 1-16 as a signal peptide.

As the invention defined by the claims currently pending meets these requirements, the Examiner is respectfully requested to reconsider and withdraw the present rejection.

***Claim Rejections - 35 USC § 102***

(1) Claims 22-34 were rejected under 35 U.S.C. 102(a) as allegedly being anticipated by Oguri et al. (WO 98/26053), which allegedly teaches a protein that has 100% sequence identity to SEQ ID NO: 24.

The cancellation of claims 30 and 31 moots their rejection. Since the remaining claims are directed to polypeptides of SEQ ID NO: 22 and variants, and not polypeptides of SEQ ID NO: 24, the present rejection is believed to be misplaced and should be withdrawn.

(2) Claims 22-34 were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Oguri et al. (U.S. Patent No. 6,338,955), which allegedly taught protein that has 100% sequence identity to SEQ ID NO: 24.


Claims 30 and 31 have been cancelled. As noted before, the remaining claims are directed to polypeptides of SEQ ID NO: 22 and variants, and not polypeptides of SEQ ID NO: 24. Accordingly, the present rejection is believed to be misplaced, and should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Should there be any further issues outstanding, the Examiner is invited to contact the undersigned attorney at the telephone number shown below to arrange a telephone or personal interview.

Please charge any additional fees, including fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39780-2930R1C7).

Respectfully submitted,

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